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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

30554.05700

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Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

09/833,448

Filed

April 12, 2001

First Named Inventor

Letovsky et al.

Art Unit

3713

Examiner

Yveste Cherubin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record. 41,030

Registration number \_\_\_\_\_.

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attorney or agent acting under 37 CFR 1.34.

January 25, 2006

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/833,448  
Applicant(s) : Letovsky *et al.*  
Filed : April 12, 2001  
TC/A.U. : 3713  
Examiner : Yveste Cherubin  
Docket No. : 30554-05700  
Customer No. : 27171  
Title : *Method and System for Broadcast and Control of a Remotely Located Wagering Device*

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

In response to the final Office action dated July 28, 2005, Applicants respectfully submit the following Pre-Appeal Brief Request for Review. A Notice of Appeal is filed concurrently herewith.

Applicants respectfully request reconsideration and withdrawal of the outstanding rejections, and allowance of the pending claims.

**I. Status of the Claims**

Claims 1-9, 11-23, and 25-34 are pending in this application, and have been rejected.

**II. Rejections Under 35 U.S.C. § 103(a)**

The Examiner finally rejected claims 1-2, 4-6, 9, 11-15, 25-27, and 34 under 35 U.S.C. § 103(a) "as being unpatentable over Karmarkar (US Patent No. 6,508,709) in view of Patel *et al.* (US Patent No. 6,731,600)." The other pending claims are also rejected under § 103 in view of

various combinations of references, all of which include Karmarkar in view of Patel *et al.*

Applicants respectfully traverse these rejections.

Claim 1, for example, is directed to an interactive gaming system that includes a data network in communication with a user computer, a gaming server in communication with the data network, and a wagering device in communication with the gaming server. The wagering device is located remotely from the user computer, and the user computer remotely controls the wagering device. *The system further includes “a bandwidth and transmission detection device, wherein transmissions between said user computer and said wagering device are optimized using encryption and compression techniques.”* This latter portion of claim 1 is the focus of the Examiner’s arguments.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of the pending claims. With reference to claim 1, for example, Applicants submit that there is insufficient evidence that one of ordinary skill in the art would have been motivated to modify Karmarkar to include the recited “bandwidth and transmission detection device.”

The Office action concedes that “[a]lthough Karmarkar uses encryption and compression techniques to transfer data, *he fails to disclose providing a bandwidth and transmission detection device to his system.*” Office action at page 2 (emphasis added by Applicants). Faced with this deficiency in Karmarkar, the Examiner argues that “Patel teaches a system and method for determining network conditions in which he includes [a] bandwidth and transmission detection device, see abstract, 6:4-15.” *Id.* at pages 2-3. The Examiner concludes that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the

detection device as taught by Patel in the Karmarkar type system in order to estimate the amount of available transmission bandwidth between the server computer and the client computer.” *Id.* at page 3.

Applicants respectfully submit that the Office action does not identify evidence that one of ordinary skill in the art – without the benefit of hindsight – would have been motivated to modify Karmarkar to achieve the claimed systems. The Examiner argues that Karmarkar discloses data compression use a video codec, and that “various communication pathways and protocols are used where the path for multimedia video source needs to be a specific bandwidth along with a specified bandwidth for the return path teach the importance of knowing the available bandwidth.” In summarizing his argument, the Examiner stresses that “the knowledge generally available to one of ordinary skill in the art would lead one to understand that since bandwidth is important to the performance of the system then measurement and testing of the bandwidth, which is well known in the art, would be paramount to the operation of the device and provide adequate motivation to find a system where such measurements are made.” *See* Office Action at pages 2-3. But as a matter of law, these observations by the Examiner are insufficient evidence to support a motivation to combine.

Under § 103, the Patent Offices bears the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, the Examiner must identify “some objective teaching in the prior art or . . . knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references.” *Id.* “The motivation,

suggestion or teaching may come explicitly from statement in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

Careful attention to the Federal Circuit’s *Kotzab* opinion highlights the Examiner’s legal error here. In particular, the Federal Circuit explains in *Kotzab* that motivation to combine or modify is *not* supported simply by evidence that a particular problem has been documented in the prior art. *See Kotzab*, 217 F.3d at 1371.

As mentioned above, the Examiner essentially argues that Karmarkar discloses a need for a specific bandwidth at specific parts of a gaming system, and that such a need is one of many *problems* that faced prior art gaming systems. But *solutions* to the stated bandwidth concerns are not limited to modifying the Karmarkar system to include a “bandwidth and transmission detection device.” Indeed, Applicants submit that one of ordinary skill faced with such a problem may have, without the benefit of hindsight reconstruction, selected a different solution (perhaps use of a more robust network connection, perhaps use of less data, etc.). The Examiner has not established that one of ordinary skill, with no knowledge of the claimed systems, would *necessarily* have been motivated to address a particular bandwidth problem using the approach(s) of Applicants’ claimed systems.

In sum, the Office action does not identify any objective teaching in the prior art or knowledge generally available to one of ordinary skill that would lead that individual to combine features of the Patel *et al.* reference with those of Karmarkar to achieve the claimed systems. Thus, Applicants respectfully submit that the Examiner’s combination of individual features

from Karmarkar with those of Patel *et al.* constitutes improper hindsight reconstruction, which does not meet the *prima facie* requirements of § 103.

**III. Authorization**

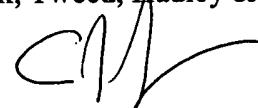
Applicants submit that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and notice of allowance to that effect is respectfully requested.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250, reference no. 30554-05700. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

In the event that a telephone conference would advance examination of this application, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

Milbank, Tweed, Hadley & McCloy LLP



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January 25, 2006

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